

U.S. Patent Application No. 09/818,168 Attorney Docket No. 85864 (8271)
Amendment dated September 24, 2007
Response to Office Action mailed May 18, 2007

REMARKS

I. Status of the Claims

The application presently stands with Claims 1-7, 22-23, and 26-33 where only Claims 1, 22, and 29 are independent. Claims 1, 3, 22, 26, and 29-32 are amended for the reasons explained below.

II. Interview Summary

Applicant thanks the Examiner for the courtesy of the telephonic interview on September 6, 2007. Applicants suggested entry of a Response without claim amendments. The Examiner made suggestions regarding possible ways to amend the independent claims that might gain allowance. No agreement was reached otherwise as to the allowance of the current state of the claims.

II. Summary of Claim Amendments

Independent Claims 1, 22, and 29 were amended to clarify that the confirmation of first and second indicators as recited in the claims is performed by a pharmacy rather than a patient or physician. Thus, Claims 1 and 29 similarly recite receiving a refill request for a patient and received by a pharmacy. Claims 1 and 29 also recite that after the pharmacy has confirmed refill request information, providing or displaying the refill request to a physician, and receiving approval of the refill request from the physician. Claim 22 recites similar language. The fact that pharmacies receive refill requests, whether directly from patients, from medical personnel, or from care givers, is inherent in the specification as would be understood by the public let alone one skilled in the art. It is also inherently supported by the language on Page 1, Lines 5-6 and Page 8, generally. As to the physician receiving and approving the refill request, this is fully supported on Page 19, Lines 1-9.

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The independent claims were also amended to clarify the difference between the first indicators, second indicators, and the information that these two indicators point to. Thus, Claim 1, for example, was amended to add examples of the first indicators from dependent Claim 3, and clarified that the "information" refers to the pharmacy identification, patient information, or medicine identification as indicated by the first indicator. Claim 3 still recites the description of the second indicators.

The independent claims were also reworded to attempt to remove confusion and to clarify that by audibly reciting a second indicator to the pharmacy, this acts to confirm that the first indicator, and in turn the underlying information (such as a pharmacy identification in one example) is correct. Claims 22 and 29 were similarly amended. No new matter is added and these terms are supported as discussed below. Claims 26 and 30-32 were amended for consistency to the amendment of Claims 22 and 29 as well as to provide proper antecedent basis.

III. Rejections under 35 USC §112

Claims 1-7, 22, 23, and 26-33 stand rejected under 35 USC §112, second paragraph as being indefinite. In response, Applicants respectfully traverse because one skilled in the art will understand what is meant by the terms "information", "first indicator", and "second indicator", and the relationship among these terms, as recited in Claims 1, 22 and 29.

First, the claims themselves explain what the terms mean. Claims 1, 22 and 29 provide examples of the information and indicate that the information includes pharmacy identification, patient identification, or identification of medication. It is clear from the claims themselves that the first and second indicators are exactly that - something that indicates the information. Claim 1 now recites examples of the first indicator. Thus, Claim 1 now recites the first indicator may be a pharmacy phone number, at least a portion of a patient's home, or a NDC number.

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Dependent Claim 3, which is now amended so that some of its subject matter is recited in Claim 1, provides examples of the second indicators of this information. For example, the first indicator may be a pharmacy phone number and the second indicator may be the name of the pharmacy for confirming the pharmacy identification. Similarly, the first indicator may be at least a portion of a patient's name and the second indicator may be a full name of the patient for confirming the patient identification. For medication, the first indicator may be an NDC number and the second indicator may be at least one of a generic name and a commercial name of the medication for confirming the medication.

As recited in Claim 1, the system uses the first indicator to retrieve the second indicator of the same information. Thus, as also recited in the claims, by the pharmacy indicating that the second indicator is correct, it confirms that the first indicator, received to look up the information, is correct, and in turn the identification or information, is also correct. With this system, the pharmacy is given a double-check (first and second indicator) to see if the correct identification is obtained. With this in mind, the way the indicators are intended to work with each other, the relationship between the indicators, and the intended results are clear – to confirm information or an identity as recited in the claims. Claims 22 and 29 recite a similar feature.

The claims also recite that the second indicator is recited audibly to the pharmacy. It is inherent in this system that listening to a second indicator and instructions rather than looking at a screen to confirm correct identification reduces the chances of error (such as hitting 'y' for yes or confirmed on a keyboard before even reading or misreading the second indicator on a computer screen). This system forces the user at the pharmacy to pay attention to an audible indicator to confirm the order. It also provides an audible system where computers may not be available to all doctors when this application was filed (See Page 2 of the Specification).

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The support and explanation in the specification for these features are discussed below with the enablement rejection.

Claims 1, 22, and 29 stand rejected under 35 USC §112, first paragraph as failing to be enabled. In response, Applicants respectfully traverse because one skilled in the art would understand the claimed terms of information and first and second indicators to be adequately described in the specification. These terms are supported in the specification as follows:

Pharmacy Identification

Pharmacy identity as the information: (Page 11, Line 19) (Page 12, Line 11)

First Indicator: (Page 12, Line 9 – step 142)

Second Indicator: (Page 12, Lines 10-11, step 144)

Patient Identification

Patient identity as information: (Page 6, Line 9) (Page 11, Lines 19-20) (Page 12, Line 15)

First Indicator: (Page 6, Lines 9-10) (Page 12, Line 17, step 146)

Second Indicator: (Page 12, Line 20, step 150)

Medication Identification

Medical identity as the information: (Page 5, Line 16) (Page 11, Line 20)

First Indicator: (Page 5, Line 20) (Page 13, Lines 6-7, step 164)

Second Indicator: (Page 5, Line 21 to Page 6, Line 1) (Page 13, Line 8, step 166)

These sections clearly explain a first indicator may be a phone number, NDC number, or partial patient name, for example. The sought information (the identification of pharmacy, patient, or medication) is requested by prompting for the first indicator. Once the first indicator is received, the corresponding information or identification is looked up and retrieved. A second indicator (pharmacy name, full patient name, or drug name) corresponding to that same information is then audibly recited to the pharmacy. By the pharmacy replying that the second indicator is correct, it is confirming that the first indicator, and therefore the information or

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identification, is correct. See Pages 5-6, 11-13 of the specification and steps 142, 144, 146, 150, 164, and 166 of FIGS. 3A-3B.

Since the specification fully enables the claims, and the claim terms are not indefinite, Applicants submit that the 35 USC §112, first and second paragraph rejections have been overcome. It is Applicants understanding that the Examiner considered the claims while giving *no* weight to the features discussed above due to the §112 rejections (Office Action of May 18, 2007, Page 3, section 4. B., Lines 19-20). Thus, in light of the explanations herein and clarifying amendments to Claims 1, 22, and 29, Applicants respectfully request that these §112 rejections be withdrawn and that all of the pending claims be reconsidered and all of the features in the claims be considered. In light of the removal of these §112 rejections, Applicants repeated some of their arguments from Amendment C below, and modified for consistency to the latest developments, for full consideration of all features.

IV. Rejection of Claims 1, 3-5, 22, and 27-28 under 35 USC §103(a)

Claims 1, 3-5, 22 and 27-28 stand rejected under 35 USC §103(a) as being unpatentable over Kobylevsky et al. (US Patent No. 6,493,427) in view of Iliff (US Patent No. 6,022,427). In response, Applicants traverse because the cited references do not disclose or suggest all of the features recited in Claim 1, for example, and more specifically:

receiving a refill request for a patient and received at a pharmacy; ...

in response to receiving the first indicator from the pharmacy, retrieving, by the system, from a database, a second indicator of the same information indicated by the first indicator ...

audibly reciting the second indicator to the pharmacy;
confirming, by the pharmacy, that the second indicator is correct,

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wherein confirming the second indicator is correct confirms that the first indicator identified the correct information;

providing the refill request from the pharmacy to the physician after the pharmacy confirms the second indicator is correct; and

receiving by the pharmacy the approval of the refill request from the physician.

as now recited in Claim 1. Similar language as to the first and second indicators are recited in Claim 22 as well as Claim 29.

This language clarifies that the pharmacy provides the first indicator, and the pharmacy audibly receives and confirms the second indicator. These steps are not performed by the patient, customer, or other medical personnel (such as the patient's physician) that is not performing on behalf of the pharmacy.

As to the rejection, Kobylevsky merely discloses that a pharmacy may call to retrieve voice messages (Col. 23, Lines 62-66). Kobylevsky discloses that this may be performed on a computer and the pharmacy employee merely presses a "play" button or the pharmacy may call a central station (Id. and Col. 29, Lines 9-31). The fact that the doctors are prompted by voice for information to leave messages for the pharmacy (Col. 7, Lines 42-45) suggests nothing more than a typical recorded instruction for the pharmacy of "if you wish to retrieve messages, press 1" for example. Nothing in Kobylevsky suggests or directs one skilled in the art to cause the pharmacy to confirm that an audibly recited second indicator is correct when the second indicator is provided in response to the pharmacy providing an audibly prompted first indicator.

The following is in response to a number of the Examiner's specific arguments.

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A. Iliff does not disclose or suggest modifying Kobylevsky to audibly prompt the pharmacy for a first indicator and then audibly reciting a second indicator as claimed (part of step b, step d and step e as labeled by the Examiner)

Iliff discloses a system for providing a customer or patient access to medical information. Thus, Iliff merely discloses audibly prompting a patient rather than prompting a pharmacy (See Col. 3, Lines 7-15 where the term "users" clearly refers to patients or customers and makes no suggestion that the user is a pharmacy itself, Col. 13, Line 59 and Col. 29 both cited by the Examiner). Thus, combining Iliff with Kobylevsky merely teaches to modify Kobylevsky to prompt the patients. Nothing in Iliff specifically directs one skilled in the art to make the extra or additional modification of Kobylevsky to audibly prompt a pharmacy with first and second indicators as recited in the claims. Only the present application and claims provide the idea of audibly prompting the pharmacy with a description of a first indicator and the second indicator as claimed.

Additionally, the Examiner's motivation to combine the references would not lead to the method recited in Claim 1 for a number of reasons. First, the motivation of "providing greater access to high quality, fast medical service at reasonable cost via a telephone network" is the general purpose of any telephone prescription service. Thus, this purpose does not direct one skilled in the art to add anything to Kobylevsky since Kobylevsky already inherently performs this motivation (See Kobylevsky, Col. 2, Lines 49-56 that describes objects of the invention including automatic processes and routing of the caller (e.g. patient) to obtain refill information which obviously increases the speed and access to medical service).

Second, at most, the motivation cited by the Examiner directs one skilled in the art to modify Kobylevsky by adding processes for communicating with the patient rather than anything to do with the pharmacy. The section for the motivation cited by the Examiner, as explained above, clearly refers to patients and customers not

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pharmacies (See e.g., Col. 3, Lines 7-15). In fact, the pharmacy is never even mentioned in Iliff.

Third, and as mentioned in Amendments A, B, and C, the problem solved by the method presently recited in Claim 1 relating to the first and second indicators is not directed to increasing the speed and access to data. Instead, Claim 1 is directed to error reduction. Thus, Claim 1 recites a method that permits the pharmacy to use a mode of communication for requesting a refill authorization that is even more accurate than simply looking at a computer screen and then typing the data into the computer. This is true since the interactive voice response system eliminates the need to visually double check something typed on a computer screen with the risk that the visual check may be performed badly or not at all. Instead, the presently claimed system forces the pharmacy to pay careful attention to what is being heard in order to obtain the desired refill authorizations (See e.g. Present Application, Page 12, Lines 3-14 (Steps 140-144 on FIG. 3A1)). Thus, the motivation of increased speed or access does not lead to the features recited in Claim 1. Since no motivation to combine the cited references exist to derive all the features recited in Claim 1 and similarly in Claim 22, Applicants request this rejection of Claims 1 and 22 and their depending claims be withdrawn.

B. Iliff does not disclose or suggest requesting the pharmacy to indicate whether or not the second indicator is correct in response to receiving a prompt for a first indicator (steps (d) and (e) as labeled by the Examiner, Office Action of May 18, 2007, Page 7, Lines 2-3)

Even if Iliff could be combined with kobylevsky, neither of the two processes cited by the Examiner disclose the claimed feature of having the pharmacy confirm a second indicator is correct after receiving a prompt for a first indicator. In contrast, Iliff discloses a confirmation loop where something is stated to the patient and the patient is asked if the statement is correct (Col. 13, Lines 55-62 as well as Col. 18 Lines 44-47 as cited by the Examiner, Office Action Page 5, Line 14). For example, a

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patient is asked for confirmation of each piece of information that it provides, e.g., age, sex, etc. by stating a piece of information to the patient and asking (yes or no) if it is correct, and then reciting the next piece of information and asking if it also correct, and so on (See FIG. 7c, and Col. 27, Lines 50-65). Assuming *arguendo* that the patient is being asked about a second indicator, no audibly prompted first indicator exists that indicates the same information as a different second indicator using different words than the first indicator for each piece of information. Instead, the confirmation is accomplished with a single indicator for each piece of information. Thus, the disclosed configuration loop does not disclose or suggest the claimed confirmation of information with first and second indicators as recited in Claim 1 and similarly with Claim 22.

In another login process also cited by the Examiner (Office Action Page 5, Lines 14-15), a previously recorded voice file for a patient is found in response to receiving a pin number (Col. 29, Lines 21-24, 47-57). But in this step of the registration process, the system does not ask the patient to confirm that the voice file is correct. Instead, the system asks the patient for his or her name to create a new voice file and then matches the new voice file to the previously recorded voice file. Further, nothing in Iliff suggests why this process should be available for a pharmacy instead of a patient. So again, the claimed feature of asking the pharmacy to confirm a first indicator is correct by providing a response as to whether a second indicator is correct as similarly recited in Claims 1 and 22 is not disclosed or suggested by Iliff. For this reason, Applicants request this rejection of Claims 1 and 22 and then depending claims be withdrawn.

For all of the reasons mentioned above, Applicants submit that the 35 USC §103(a) rejection based on Kobylevsky in view of Ilaff, and of independent Claim 1, as well as Claim 22 which recites similar features to that recited in Claim 1, and their respectively depending Claims 2-4, 6-7, 23, and 26-28 have been overcome and withdrawal of the rejection is respectfully requested.

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C. 35 U.S.C. §103 (a) Rejection of Claim 3

Regarding Claim 3, Iliff does not disclose or suggest a second indicator is a full name as recited in Claim 3. Claim 3 depends from Claim 1 and therefore includes all of the features of Claim 1. Thus, the second indicator (full name for example) is provided in response to providing the first indicator (partial name) as recited in Claim 1. The section of Iliff cited by the Examiner merely states that a voice file of a patient's name is provided in response to a pin rather than having anything to do with a portion of the patient's name being provided by the pharmacy before a full name is recited (Col. 29, Lines 54-57). For this additional reason, Applicants submits that the §103(a) rejection of Claim 3 has been overcome and respectfully requests that this rejection be withdrawn.

D. 35 U.S.C. §103 (a) Rejection of Claim 28

Claim 28 includes a further alternative feature of the invention to clarify that the pharmacy cannot obtain refill prescription information through the interactive voice response system unless the second indicator is correct. Thus, Applicants submit that this rejection is already overcome by the arguments above for Claim 1 from which it depends. Thus, Applicants respectfully request that this rejection be withdrawn.

IV. Rejection of Claims 2, 6, 7, and 23 under 35 U.S.C. §103(a)

Claims 2, 6, 7 and 23 stand rejected under 35 U.S.C. §103(a) as being obvious to Kobylevsky in view of Goetz. In response, these claims all depend directly or indirectly from Claim 1 or 22, and therefore include all of the features of Claim 1 or 22 plus other features. Thus, Applicants submit that for the reasons mentioned above to overcome the rejection of Claim 1, the rejections of these claims are also overcome. Accordingly, Applicants respectfully request that the 35 U.S.C. §103(a) of Claims 2, 6, 7, and 23 be withdrawn.

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V. Rejection of Claims 29 and 33 under 35 USC §103(a)

Claims 29 and 33 stand rejected under 35 USC §103(a) as being unpatentable over Kobylevsky et al. (US Patent No. 6,493,427) in view of Goetz et al. (US Patent No. 6,421,650). In response, Applicants traverse first by repeating the arguments from above that nothing in Kobylevsky, and similarly nothing in Goetz or any of the other references, discloses or suggests that a pharmacy should confirm "the first indicator identified the correct information" by "audibly reciting the second indicator of the information" as now recited in Claim 29. The Examiner asserts that the latter portion of this feature is disclosed by reciting an Rx number in Kobylevsky (citing Col. 25, Lines 21-23 of Kobylevsky, Office Action of May 18, 2007, Page 16, step (e)). This is not correct, however, because this portion of Kobylevsky specifically states "...the system will playback to customers the entered Rx numbers for verification." Kobylevsky, Col. 25, Lines 21-23. Nothing in this statement or section of Kobylevsky suggests audibly prompting a pharmacy by stating a second indicator. Goetz provides no suggestion of this feature either. Thus, for this reason, Applicants submit that the §103(a) rejection of Claim 29 and its depending Claim 33 have been overcome and respectfully request that the §103(a) rejection of Claims 29 and 33 be withdrawn.

In addition, the cited references, alone or in combination, do not disclose or suggest audibly reciting the second indicator. The Examiner asserts that the first indicator is an Rx number (Office Action of May 18, 2007, Page 15, Line 7 (step (a)), and the second indicator is the telephone number where the patient can be reached (Office Action of May 18, 2007, Page 17, Line 17). Kobylevsky does not disclose or teach audibly reciting this phone number (See Col. 25, Lines 21-23 cited by the Examiner). For this additional reason, Applicants submit that the §103(a) rejection of Claim 29 and its depending Claim 33 have been overcome and respectfully request that this rejection be withdrawn.

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VI. Rejection of Claims 30-32 under 35 USC §103(a)

Claims 30-32 stand rejected under 35 USC §103(a) as being unpatentable over Kobylevsky et al. (US Patent No. 6,493,427) in view of Goetz et al. (US Patent No. 6,421,650) and further in view of Pilarczyk (U.S. Patent No. 4,766,542). In response, Applicants traverse because Claims 30-32 depend directly or indirectly from Claim 29, and therefore, include all of the features of Claim 29 plus other features. Thus, Applicants repeat the reasons mentioned above to overcome the §103(a) rejection of Claim 29 and adds that Pilarczyk does not disclose or suggest specifically providing audible statements to a pharmacy and with first and second indicators as recited in Claim 29. Thus, Applicants submit that the §103(a) rejection of Claims 30-32 has also been overcome. Accordingly, Applicants respectfully request that the §103(a) rejection of Claims 30-32 over Kobylevsky in view of Goetz and Pilarczyk be withdrawn.

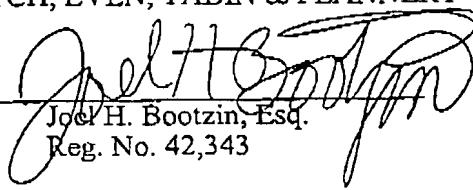
CONCLUSION

For all the reasons mentioned above, Applicants respectfully request reconsideration and allowance of all pending claims. The Examiner is invited to contact the undersigned attorney to expedite prosecution.

Very truly yours,

FITCH, EVEN, TABIN & FLANNERY

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